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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,980	09/03/2002	Tracey Cooke	P/3610-26	2665

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EXAMINER

QAZI, SABIHA NAIM

ART UNIT PAPER NUMBER

1616

DATE MAILED: 09/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/049,980	<b>Applicant(s)</b> COOKE ET AL.	
	<b>Examiner</b> Sabiha Qazi	<b>Art Unit</b> 1616	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 01 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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***Non Office Final Action***

Acknowledgement is made of the response filed on 06/01/04. Amendments are entered. Claims 1 and 2 are pending. No claim is allowed. Claims 1-2 are examined to a subgenus of elected species, i.e. compounds of Table B when L is (ly)). Rejections are withdrawn because claims are amended. Elected invention is compound 102 disclosed in Table B on page 4.

This application is a 371 of PCT/EP00/08268 filed on 08/11/2000, which claims priority of UK 9919558.8-dated 08/18/1999.

Presently claimed invention is drawn to a method of controlling the pests by the compounds of formula 1. The compounds are 3-CL-CF<sub>3</sub>-2-pyridyl derivatives linked to a optionally substituted heterocyclyl or an optionally substituted carbocyclyl group via a 3-atom linker. Prior art of record discloses 2-pyridyl compounds as fungicides.

Applicant's arguments regarding lack of unity were fully considered but are not found persuasive. Examiner respectfully disagrees that "the molecular structures of the compounds recited in the subject claims have molecular structures with sufficient commonality to be prosecuted in a single application without subjecting the Examiner to an undue burden". The fact is that compounds of formula 1 belong to different categories of invention that makes such argument moot as it is well established that different categories of invention require different consideration search and examination. There is no common core of the compounds of formula 1.

Applicant's attention is drawn to International search report where it was established that that application does not meet the requirement of Art. 33(3) PCT.

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Examples in the specification where A<sub>2</sub> can be various groups that belong to divergent subject matter containing various hetero and non-hetero groups. For example see Table A compound 19 which contains a dioxarane ring, compound 1015 contain pyrimidine, compound 1003 contain pyrazinyl, Table J where A<sub>2</sub> can be thiazolyl and morpholine derivative. These belong to different class of compounds totally different from each other. Applicant should cancel all the non-elected invention. There is no common core. Only pyridyl represented by A<sub>1</sub> group is non-variable part of the compounds of claim 1.

Lack of unity exists because claims are directed to more than 1 species is (actually more than thousand species) of the generic invention. These species are deemed to lack of unity because they are not so linked to form a single inventive concept under PCT Rule 13.1. This application does not comply with the requirement of unity of invention (Rules 13.1, 13.2 and 13.3).

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1 and 2 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10-12 of recently allowed

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Application No. 10/049,976. Although the conflicting claims are not identical, they are not patentably distinct from each other because methods of controlling the pest as presently claimed were claimed in the said application. The compounds are generically disclosed and overlap the presently claimed compounds used for the control of pests. Details as described in the following rejection.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

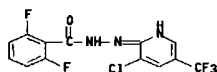
This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

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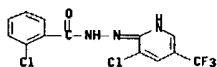
evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over AN 1988:524419, HCAPLUS, abstract of EP 270061. The reference teaches 2-pyridyl compounds and their compositions for the control of pests, which embraces presently, claimed invention. See the entire document especially formula 1 and these compounds.

RN 116389-03-8



RN 116389-04-9



Instant claims are generically taught by the prior art when X in formula 1 is N, R1= pyridyl and R2 is phenyl. Examiner notes that compounds containing X as O or S are disclaimed by a proviso in claim 1.

It would have been obvious to one skilled in the art at the time of invention to select any substituent from formula disclosed by the prior art to prepare compounds useful for controlling the pests. Since prior art teaches the same use of these compounds there is a motivation to select the compounds for the same use as taught by the prior art. The effect of exact arrangement of 3-

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atom linker is not critical. Specification does not disclose any unexpected activity. Therefore, presently claimed invention is considered *prima facie* obvious over the prior art cited above.

Heterocyclyls as described in lines 12-24 on page 3 of the specification can be wide variety of 5 and 6 membered heterocyclic groups. A single species is seldom, if ever, sufficient to support a generic claim. In re Shokal, 242 F.2d 771, 113 U.S.P.Q. 283, 285 (C.C.P.A. 1957). See also, In re Grimme, 274 F.2d 949, , 124 U.S.P.Q. 499, 501 (C.C.P.A. 1960) (the naming of a member of a genus or subgenus is not a proper basis for claiming the whole group). Objective evidence of nonobviousness must be commensurate in scope with the scope of the claims. In re Tiffin, 171 USPQ 294. A showing limited to a single species can hardly be considered probative of the invention's nonobviousness in view of the breadth of the claims.

Examiner notes the results and test examples disclosed on page 46. The results do not appear to be unexpected. This also shows a limited group.

In the light of the forgoing discussion, the Examiner's ultimate legal conclusion is that the subject matter defined by the instant claims would have been obvious within the meaning of 35 U.S.C. 103(a).

#### ***Communication***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha Qazi whose telephone number is (571) 272-0622. The examiner can normally be reached on any business day. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz can be reached on (571) 272-0887. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Friday, August 27, 2004



SABIHA QAZI, PH.D  
PRIMARY EXAMINER